



Dkt. 0575/50950/JPW/AJM/BJA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9
Plunkett
6/12/01

Applicants : Wayne A. Hendrickson et al.
U.S. Serial No. : 09/609,027 Examiner: M. Sheinberg
Filed : June 29, 2000 Group Art Unit: 1631

For
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CONJUGATED LIGANDS FOR THE STIMULATION
OF BLOOD CELL PROLIFERATION BY
EFFECTING DIMERIZATION OF THE RECEPTOR
FOR STEM CELL FACTOR

TECH CENTER 1600/2900

1185 Avenue of the Americas
New York, New York 10036
June 1, 2001

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO MAY 8, 2001 OFFICE ACTION

This Communication is submitted in response to the Office Action issued May 8, 2001 by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the May 8, 2001 Office Action is due June 8, 2001. Accordingly, this Communication is being timely filed.

Restriction Requirement Under 35 U.S.C. §121

In the May 8, 2001 Office Action, the Examiner to whom the subject application is assigned required restriction under 35 U.S.C. §121 to one of the following inventions:

- I. Claims 1-6, drawn to a method for preparing a stem cell factor, classified in class 702, subclass 19;
- II. Claims 7-10, 29-31 and 39-47, drawn to a composition, classified in class 530, subclass 350;

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- III. Claims 11-14 and 32-38, drawn to a treatment method, classified in class 514, subclass 2; and
- IV. Claims 15-28, drawn to a method of designing a compound, classified in class 395, subclass 500.23.

The Examiner alleged that the inventions are distinct, each from the other, for the reasons set forth in the Office Action.

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Group IV, i.e., Claims 15-28, drawn to a method of designing a compound.

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of Groups I-IV are not independent.

Under M.P.E.P. §802.1, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, and effect..." The claims of Groups I-IV are related in that they are drawn, respectively, to SCF preparation methods, SCF analogs per se, methods of using such analogs, and methods of designing such analogs.

Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under

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M.P.E.P. §802.01. Therefore, restriction is improper under 35 U.S.C. §121.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; and (2) there must be a serious burden on the Examiner if restriction is not required.

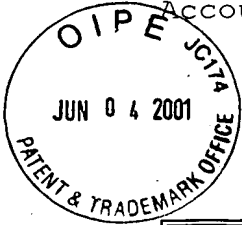
Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any of Groups I-IV would necessarily identify art for the other Groups. Since there is no serious burden on the Examiner to examine Groups I-IV in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, in view of the preceding remarks, applicants respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

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No fee is deemed necessary in connection with the filing of this Communication. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.



Respectfully submitted,

A handwritten signature in dark ink, appearing to be "John P. White", written over a horizontal line.

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

A handwritten signature in dark ink, appearing to be "Alan J. Morrison", written over a horizontal line.
Alan J. Morrison
Reg. No. 37,399

A handwritten date "6/1/01" in dark ink, written over a horizontal line.
Date